

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1, 5-9, 13-17, 21-25, and 29-36 are pending in this application. Claims 33-36 are added by the present response. Claims 1, 5-9, 13-17, 21-25, and 29-32 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1, 3-9, 11-17, 19-25, and 27-32 of co-pending U.S. application serial no. 09/440,692. Claims 1, 5-9, 13-17, 21-25, and 29-32 were rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1, 5-8, 12-15, 19-22, and 26-28 of co-pending U.S. application serial no. 09/311,148. Claims 1, 5-9, 13-17, 21-25, and 29-32 were rejected under 35 U.S.C. § 103 as unpatentable over U.S. patent 5,566,291 to Boulton et al. (herein “Boulton”) in view of U.S. patent 6,181,981 to Varga et al. (herein “Varga”).

Addressing first the above-noted double patenting rejections, those rejections are traversed by the present response. More specifically, filed with the present response is a Terminal Disclaimer over U.S. application serial no. 09/311,148. The submission of that Terminal Disclaimer is believed to address that double patenting rejection.

With respect to the double patenting rejection over U.S. application serial no. 09/440,692, a Terminal Disclaimer was already filed over that application on May 27, 2005, and thus that double patenting rejection is believed to have been already addressed.

Addressing now the rejection of claims 1, 5-9, 13-17, 21-25, and 29-32 under 35 U.S.C. § 103 as unpatentable over Boulton in view of Varga, that rejection is traversed by the present response.

Initially, applicants note each of the independent claims is amended by the present response to even further clarify that the monitoring unit starts the monitoring “automatically upon start-up of the image forming device without the user directly starting a monitoring

program.” That feature is similar to a feature recited in co-pending U.S. application serial no. 09/311,148, which was found allowable based on a Board of Appeals decision. Such a feature is believed to even further distinguish the claims as currently written over the applied art.

The independent claims are also amended by the present response to delete “the log of the monitored data being in a form of an abstract class”. However, that feature has now been added in new respective dependent claims 33-36.

The claims are directed to a system in which a user’s selection of operations on an interface of an image forming device, for example a facsimile, a copier, a printer, a scanner, are monitored. That is, as recited in the claims, how a user utilizes an interface of an image forming device is monitored. Further, that monitoring is effectuated without the user having to directly start a monitoring program. Those features recited in the claims are believed to clearly distinguish over the applied art.

As discussed in the present specification for example at page 20, line 22 et seq., when a target application MB starts up, the MB object calls a function startMonitoring of a CMonitoringIF object 1305, which begins logging data corresponding to a user’s usage of a user interface 510. Thus, the monitoring is automatic upon start-up of the target application and does not require the user to directly execute a specific monitoring program, i.e. the user does not need to take any action besides starting up the target application to begin the monitoring.

The above-noted features are believed to clearly distinguish over the applied art.

The basis for the outstanding rejection recognizes deficiencies in Boulton not teaching automatically starting a monitoring without requiring a connection to a receiving device to which the log of the monitored data is to be sent. In that respect applicants note Boulton also clearly fails to teach or suggest, and in fact teaches directly away from, “automatically

starting a monitoring upon start-up of an image forming device without the user directly starting the monitoring program". To overcome the recognized deficiencies in Boulton the outstanding Office Action cites Varga, particularly noting column 2, line 65 to column 3, line 13.

In reply to that basis for the outstanding rejection applicants submit Varga is completely unrelated to Boulton and that no combination of teachings of Varga and Boulton meets the claim limitations.

First, Varga is directed to an inventory maintenance for a vending machine. Such a disclosure in Varga is completely unrelated and has no relevance whatsoever to the device of Boulton. Boulton is directed to a system in which a user can input specified typed commands as feedback after entering an enter feedback mode. A disclosure to monitoring the inventory of a vending machine has no relevance whatsoever to such a device, and it would be nonsensical to one of ordinary skill in the art to try to attempt to combine such teachings. Clearly the only basis for combining the teachings is to make an improper hindsight reconstruction of the claims.

In fact the stated motivation to combine the teachings of Varga to Boulton is "to make it easy for the user by not requiring him/her to directly execute a specific monitoring program".<sup>1</sup>

That basis for the outstanding rejection is not understood and in fact is *directly contrary to the teachings in Boulton*. Boulton clearly could not have been modified by the teachings in Varga to meet the claim limitations.

More particular, Boulton is specifically directed to a device for allowing user feedback. In Boulton "feedback" is defined as comments, suggestions, questions, or other information sent by a user or learner to an author of the learning material, reviewer of the

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<sup>1</sup> Office Action of June 30, 2006, the sentence bridging pages 5 and 6.

learning system, providing of a product, process, service, or issue, or other person responsible for improvement, maintenance, organization, or content of a product, process, or service.<sup>2</sup> In such ways, in Boulton the user is *required* to input the monitored information to be provided to the reviewing party. Further, it is also clear from Boulton for example from Figure 20, step 286, and the disclosure at column 39, lines 42-47 and column 40, lines 1-3, that in Boulton a user must initiate an action to even perform the “feedback” therein. That operation in Boulton is directly contrary to the claimed features in which the monitoring is performed automatically upon start-up of the image forming device without the user directly starting a monitoring program. Moreover, as such, it would be impossible to modify Boulton to start a monitoring progress automatically because in Boulton the entire monitoring process is the *user typing in comments*. It is simply not possible for such an operation to occur without a user starting the monitoring as again in Boulton the monitoring is the user typing in comments or suggestions.

In such ways, it would not have been possible to one of ordinary skill in the art to modify the teachings in Boulton in view of the teachings of Varga in the manner suggested in the outstanding Office Action.

In view of these foregoing comments, applicants respectfully submit clearly no combination of teachings of Boulton in view of Varga would have been suggested to one of ordinary skill in the art.

Applicants also draw attention to the decision by the Board of Appeals in related application serial no. 09/311,148. Applicants submit the Board in that related case found the positions advanced by the Examiner, which are similar to the positions presented in the present application, to be unfounded. In that decision the Board recognized that Boulton provided an “explicit requirement … of the user activating an enter feed mode command to

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<sup>2</sup> Boulton at column 8, lines 59-65.

initiate the user feedback operations that are extensively shown and discussed in Boulton".<sup>3</sup>

Applicants respectfully submit that in view of the above-noted comments clearly Varga does not overcome such express disclosures in Boulton, for similar reasons as recognized in the noted Board of Appeals decision.

In view of these foregoing comments applicants respectfully submit the claims as currently written clearly distinguish over the applied art.

As no other issues are pending in this application, it is respectfully submitted that the present application is now in condition for allowance, and it is hereby respectfully requested that this case be passed to issue.

Respectfully submitted,

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<sup>3</sup> Board Decision in 09/311,148, bottom of page 5.